IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/750,517	Confirmation No. 9240
Applicants	:	Michael G. Lisanke et al.	
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Examiner	:	Harris C. Wang	
Docket No.	:	SOM920030007US1	
Customer No.	:	78007	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are submitted to be considered along with the Appellant's notice of appeal. The references and/or combination of references cited by the Examiner do not teach or suggest the presently claimed invention.

SUPPORT FOR CLAIM LANGUAGE

The Examiner rejected claims 1-22 under 35 U.S.C. §112, first paragraph stating that independent claims 1, 10, 15, and 20 contain new subject matter. Appellants respectfully disagree with the Examiner.

(A) The following chart lists the language that the Examiner states is new matter and also identifies examples where support for this language can be found in the U.S. Pre-Grant Publication No. 2005/0149750.

(1) wherein the one instance is identified and selected by an end-user to be monitored by the processor	FIG. 8 and paragraphs [0016], [0017], [0018], [0050], and [0051]
(2) wherein the end-user is a user that initiates execution of the software at a system associated with the end-user,	FIG. 8 and paragraphs [0050], and [0051]
(3) and wherein the processor creates a log entry with at least one set of data derived from the one instance of software execution in response to the one instance being identified and selected to be monitored…	FIG. 2 and FIG. 8 and paragraphs [0017], [0018], and [0051]

As can be seen from the above chart, the Specification as originally filed comprises sufficient support for the claim language added in the Response With Amendment dated January 2, 2008. The Examiner argues that because the Specification states that an advantage of the present invention is that the "content of messages logged are all obscured from the user of the system on which the logging is done…it is more difficult for the user to determine what is being logged" that a user would be unable to select an instance of software execution to be monitored. However, this argument is misplaced. For example, the Specification as originally filed does not state that a user cannot select an instance of execution to be monitored, but that the user would have a difficult time finding the log and identifying the data in the log. See paragraph [0019] of the Specification as originally filed. Paragraphs [0050] and [0051] clearly show that a user can select an instance of software execution and have that instance

monitored. Accordingly, Appellants respectfully suggest that the rejection of claims 1-22 under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn.

CLAIMS 1-22 ARE PATENTABLE OVER THE CITED ART

(B) With respect to claim 1, nowhere does Circenis teach or suggest that the end-user selects a particular instance of software execution for monitoring. In fact, the entire focus of Circenis is to detect end-user tampering of usage data. The **data owner** of Circenis configures an application to monitor every instance of an application use, CPU operation, or whatever data is being collected. (See Circenis at, for example, the Abstract and paragraphs [0018] and [0019]. The presently claimed invention, on the other, hand, is only monitoring a specific instance of a software execution **that has been selected by the end-user**. The Examiner argues that because the processor of Circenis is monitoring every instance of execution that when an end-user executes the software on a device this constitutes the end-user identifying the instance of execution to be monitored. However, this argument in appropriately broadens the scope of Circenis in view of the teachings in Circenis. The independent claims explicitly recite "wherein the one instance is identified and selected by an end-user to be monitored by the processor, wherein the end-user is a user that initiates execution of the software at a system associated with the end-user, and wherein the processor creates a log entry with at least one set of data derived from the one instance of software execution in response to the one instance being identified and selected to be monitored..." In other words, the end-user of the presently claimed invention is explicitly identifying and selecting an instance of software execution to be monitored by the processor.

Circenis explicitly teaches that the data owner configures an application to monitor every instance of application user. Therefore, it is the data owner in Circenis who identifies and selects every instance of application user to be monitored and not the end-user. Circenis only teaches that customer executes an application. Nowhere does Circenis teach or suggest that the customer selects an instance of execution for monitoring. In fact, Circenis teaches away from this claim element. The entire purpose of Circenis is to detect any tampering of a file by a user. Therefore, if a user was given the ability select an instance of software execution to be monitored as recited for the presently claimed invention, the tamper-evident management system in Circenis would be defeated. Because Circenis explicitly teaches that a data owner configures an application to monitor each execution of an application and that a customer merely uses an application, the Examiner's argument that the processor of Circenis is monitoring every instance of execution that when an end-user executes the software on a device this constitutes the end-user identifying the instance of execution to be monitored is improper. Accordingly, the presently claimed invention distinguishes over Circenis for at least these reasons.

Furthermore, the monitoring of the presently claimed invention is performed on the instances selected by the end-user. Circenis is completely silent on this claim element. For example, Circenis teaches a metering application that collects "metrics data associated with operation of the computer system" whenever a user uses an application. See Circenis at paragraph [0019]. If a user uses an application 5 times, Circenis teaches that usage information for each of the 5 times is recorded. Assuming arguendo that Circenis and the presently claimed invention teaches logging and monitoring the same type of data (which they do not), Circenis would have to teach that of the 5 times an application is used a user can select which of the 5 times data should be logged. Circenis clearly does not teach this. In fact, this is completely against what Circenis is trying to accomplish as stated above. The Examiner states in the Response to Arguments section of the Final Office Action that the claim language does not states that the monitoring is only performed on the instances selected by the end-user. However, the claim

language does explicitly state that the monitoring is performed on the instance identified and selected by the end-user to be monitored which differs from monitoring each application user as configured by a data owner, which is taught by Circenis. The claim language differs from arbitrarily monitoring every instance of software execution by reciting that the instance identified and selected by a user to be monitored is the instance that is monitored by the processor. Accordingly, the presently claimed invention distinguishes over Circenis for at least these reasons as well.

(C) With respect to claim 7, the Examiner states "Paragraph [0019] teaches a mechanism for receiving an input from an end-user that initiates logging of log entries, as shown by the "pay per use metering application that collects metrics data associated with computer system) The user can use the system as many times as desired. The logger logs each use of the system. Therefore, logging is initiated as desired by the end user." However, nowhere does Circenis teach or suggest that an end-user can initiate logging as desired by an end-user, as this would defeat the purpose of Circenis where the data owner, not the customer, configures when monitoring of an application is performed. The focus of Circenis is to determine if a customer has tampered with an application. Therefore, if a user can initiate logging as desired the main focus of Circenis would be defeated. Accordingly, the presently claimed invention distinguishes over Circenis for at least these reasons as well.

(D) With respect to claim 8, the Examiner states that Circenis teaches "an initializing mechanism for determining each instance logging is to begin and initiating logging of log entries only in response to that initializing mechanism. ("The iCOD computer could save usage data to a log file or a central metering device" Paragraph [0024] Circenis) ("an iCOD computer residing on an isolated site should be designed to discourage any reverse engineering or other tampering and to make such tampering evident to the iCOD computer vendor" Paragraph [0023] Circenis) The Examiner interprets the iCOD inherently having an initializing mechanism. The Examiner interprets the design to discourage tampering as so that only logging entries are only initiated in response to the initializing mechanism." The Appellants respectfully suggest that the Examiner is improperly reading Circenis well beyond the scope of Circenis. For example, the teaching of "[t]he vendor would likely want a method for accounting and auditing usage to ensure that the customers were not tampering with the CPU usage data" at paragraph [00023] of Circenis does not suggest that a vendor employee restarts the logging process once the employee checks the log. Nowhere does Circenis suggest that the vendor initiates logging. Nowhere does Circenis suggest that the vendor has access to a customer's system. The vendor merely configures an application to performing a monitoring operation. This monitoring operation runs every time a customer uses an application. Circenis does not suggest that monitoring stops and is restarted by a vendor. The teaching of "[t]he vendor would likely want a method for accounting and auditing usage to ensure that the customers were not tampering with the CPU usage data" does not suggest any of the conclusions made by the Examiner. Accordingly the presently claimed invention distinguishes over Circenis for at least these reasons as well.

(E) The Examiner correctly states that Circenis and the IBM reference do not explicitly teach "random data in the log file when it is originally created and which is replaced by log entries so that a size of the log including log entries appears to by a substantially-constant size". The Examiner goes on to state "It would have been obvious to one or ordinary skill in the art at the time of the invention to insert random data into the log file when it is initially created. The motivation is to initialize the circular log."

Appellants respectfully disagree with the Examiner's interpretation of the IBM reference. As discussed in the previous two Responses With Amendment, it is not customary to insert random data into log files. The Examiner in the Response to Arguments section of the Final Office Action states "The Examiner never argues that it is inherent that the circular file is always populated with random data when created, only that the file is populated with some data when created. Whenever a file is created, of any size, some value is inside the file. Even in a blank entry, some value exists inside the file." However, the presently claimed invention does not recite that the log file is merely populated with some data, but is populated with "random data in the log file when it is originally created and which is replaced by log entries so that a size of the log file including log entries appears to be a substantially constant size". Merely populating a file with some data does not result in "a size of the log file including log entries appears to be a substantially constant size". Also, a fixed-size files do not have to be initialized with random data. A fixed-sized file such as that taught by the IBM reference can be defined as a file that cannot exceed a certain size. For example, if the file is fixed at 100 bytes, the file can comprise any number of bytes from 0 to 100, but not exceed 100 bytes. The presently claimed invention, on the other hand, inserts random data into the log file at its creation so that the log file appears to be a substantially constant size no matter how many log entries are in the log file.

Accordingly, Appellants assert that it would not have been obvious to one or ordinary skill in the art at the time of the invention to insert random data into the log file when it is initially created. A circular file can have a maximum size associated with it and when this maximum size is reached, old data is re-written, thereby creating a circular file. In fact, the IBM reference states that "the alog file…is a cyclic file so, when its size gets to the maximum, it is overwritten". This clearly shows that the circular file of the IBM reference is not populated with random data when it is generated and is only set to a maximum file size. Therefore, the inherency argued by the Examiner does not exist. If the presently claimed element is inherent and obvious, then Appellants respectfully request that the Examiner provide references teaching "…a log file of a relatively-fixed size which stores the log entry for the at least one set of data which has been encrypted, and wherein the log file includes the symmetric key which has been encrypted with the public key; random data in the log file when it is originally created and which is replaced by log entries so that a size of the log file including log entries appears to be a substantially constant size…" Accordingly, claim 1 (and similarly claims 10, 15, and 20) distinguishes over Circenis alone and/or in view of the IBM reference.

(F) Independent claims 10, 15, and 20 recite similar to independent claim 1. Therefore, the remarks and arguments made above with respect to independent claim 1 are also applicable in support of independent claims 10, 15, and 20 as well and will not be repeated.

For the foregoing reasons, Claims 1-22 distinguish over Circenis alone and/or in combination with the IBM reference. Claims 2-9, 11-14, 16-19, and 21-22 depend from claims 1, 10, 15, and 20, respectively. Since dependent claims include all the limitations of the independent claims, claims 2-9, 11-14, 16-19, and 21-22 distinguish over Circenis alone and/or in combination with the IBM reference, as well. Accordingly, Appellants believe that the rejection under 35 U.S.C. § 103(a) has been overcome and respectfully request that this rejection be withdrawn.

Appellants hereby respectfully request reconsideration and allowance of pending claims 1-22 of the instant application.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

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